

### **REMARKS/ARGUMENTS**

In response to the Office Action dated June 22, 2004, Applicant has amended the claims, and added new claims, to more clearly define embodiments consistent with the present invention. Claims 1, 3-11, 13-17, 21, and 22 are pending. Reconsideration and allowance of all pending claims are respectfully requested.

The disclosure was objected to due to informalities identified by the Examiner. Applicant has amended the Specification to correct the informalities.

Claim 3 was rejected under 35 U.S.C. § 101 as being inoperative and under 35 U.S.C. § 112 for not complying with the enablement requirement in that it recited the ability of the holders to hold "one or more" cosmetic tools. Applicant has amended claim 3 to correctly recite that each holder can hold one of the listed examples of cosmetic tools.

Claims 1, 2, 4, 5, 7-12, 16, 17, and 20 were rejected under 35 U.S.C. § 102 as being anticipated by the Bolser patent. Applicant respectfully submits that independent claims 1 and 16, and new claims 21 and 22, are patentable over the cited references for at least the following reasons.

#### **Independent Claim 1**

Claim 1 has been amended to recite the use of two friction fit holders for releasably holding cosmetic tools and that "the first holder has a different cross-sectional diameter than the second holder." This configuration can be useful "in order for the first and second holders to releasably hold, respectively, the first and second cosmetic tools when the first cosmetic tool has a different cross-sectional diameter than the second cosmetic tool."

In the Bolser patent, both holders and tools have the same shape and cross-sectional diameter for the same purpose, application of nail polish. (See Bolser patent, Figs. 1 and 2). In comparison, claim 1 requires friction fit holders of different diameters for holding cosmetic tools having different cross-sectional diameters. The Bolser patent thus does not satisfy at least that element of claim 1.

As shown in Applicant's specification and in the submitted references, conventional cosmetic tools often have different cross-sectional diameters, even for tools used for the same purpose. (See Information Disclosure Statement filed October 30,

2003 (identifying product brochures listed under Other References); see also Specification, Figs. 3-8; p. 10, lines 27-28 (illustrating a holder 10 having different diameter friction holders on its ends)). Using friction fit holders of different diameters allows more flexibility in configuring the holder for a wide range and variety of cosmetic tools, a distinct advantage over the Bolser patent. Every embodiment in the Bolser patent shows two holders of identical diameter, consistent also with its description, and Applicant thus respectfully submits that the Bolser patent provides no suggestion for having holders of different diameters.

Applicant respectfully submits that the other cited references likewise do not disclose or suggest the invention defined in claim 1. The Kay et al. patent was cited for disclosing a particular type of tool, a lip or eye liner product, and does not disclose releasable holders for two conventional cosmetic tools. The Bunk patent was cited for disclosing a reflective outer surface for use with a conventional single lipstick holder, and it does not disclose releasably holding a conventional cosmetic tool. The Huang patent was cited for disclosing a threaded aperture and, like the Bolser patent, it does not disclose a releasable holder for a conventional cosmetic tool nor two holders of different diameters. The Kageyama et al. ('693) was cited for disclosing use of a chuck mechanism, and it does not disclose releasable holders for two conventional cosmetic tools. The Rosenthal patent was cited for disclosing use of a compressible material, and it does not disclose a releasable holder for a conventional cosmetic tool.

It is possible that other types of holders, such as a chuck mechanism or compressible material, can hold tools having variable dimensions or diameters. For example, the Kageyama et al. ('693) patent illustrates use of a chuck mechanism, and the Rosenthal patent illustrates use of a compressible material. However, claim 1 specifically recites use of friction fit holders. Therefore, even if a compressible material or chuck mechanism were used in the holders of the Bolser patent, that combination would not satisfy all elements of claim 1. The Kageyama et al. ('693) and Rosenthal patents do not disclose or suggest use of only friction fit holders.

Accordingly, Applicant respectfully submits that claim 1 is patentable over the cited references.

**Independent Claim 16**

Claim 16 has been amended to recite that both holders releasably hold conventional cosmetic tools and that "at least a portion of an outer surface of the main body is composed of a reflective material for use as a mirror."

The Bolser patent does not disclose a reflective surface on a main body for use as a mirror. The Bunk patent was cited for disclosing a reflective outer surface for use with a conventional single lipstick holder. However, it does not disclose use of a reflective surface on a main body of a holder for use as a mirror nor releasably holding a conventional cosmetic tool. The reflective surface of the lipstick holder in the Bunk patent is on the end of its cap, and it provides no suggestion for using a reflective surface on the portion holding the lipstick product. Since that holder for a conventional cosmetic tool is required for application of the lipstick product, a person could not practically use that surface as a mirror when applying the product.

In comparison, the holders of claim 16 both releasably hold conventional cosmetic products. Therefore, a person could remove the product and then apply them using the main body as a mirror. Also, having a reflective surface on the main body for use as a mirror obviates the previous need to carry three separate loose articles, including a compact mirror. (See Specification, p. 1, lines 17-20 (stating that application of lipstick requires a person to carry three separate articles)). Without the need for a reflective surface on the caps, the holder does not necessarily need additional caps, aside from those on the conventional cosmetic tools. (See Specification, p. 10, lines 17-19 (stating that the outer surface of the main body can be composed of a reflective material for use as a mirror)).

As identified above, the other cited patents were relied upon for different reasons and likewise do not disclose or suggest a reflective surface on a main body of a holder for use as a mirror. The Kay et al., Huang, Kageyama et al. ('693), and Rosenthal patents do not disclose releasably holding conventional cosmetic tools. In addition, where the main body of a holder for a cosmetic product is required for the application of it, a reflective surface on the main body would not be useful as a mirror during the application.

Accordingly, Applicant respectfully submits that claim 16 is patentable over the cited references.

New Claims 21 and 22

New independent claim 21 recites the use of two holders each having a compressible material for releasably holding a conventional cosmetic tool and an aperture in the compressible material for receiving a tool. It also recites that "the aperture in the compressible material in the first holder has a different cross-sectional diameter than the aperture in the compressible material in the second holder." This configuration can be useful "in order for the first and second holders to releasably hold, respectively, the first and second cosmetic tools when the first cosmetic tool has a different cross-sectional diameter than the second cosmetic tool."

Applicant respectfully submits that the cited references do not disclose or suggest this combination of elements. First, as explained above with respect to claim 1, none of the cited references disclose or suggest use of holders having different cross-sectional diameters for releasably holding conventional cosmetic tools having different cross-sectional diameters. Second, the Rosenthal patent, which does disclose use of a compressible material, does not disclose or suggest use of a curved portion in the material for receiving a conventional cosmetic tool.

New dependent claim 22 recites that "at least a portion of an outer surface of the main body is composed of a reflective material for use as a mirror." For the reasons provided above with respect to claim 16, Applicant respectfully submits that the cited references do not disclose or suggest a reflective surface on a main body of a holder for use as a mirror.

Accordingly, Applicant respectfully submits that claims 21 and 22 are patentable over the cited references.

Dependent Claims 2, 4, 5, 7-12, 17, and 20

Claims 2, 12, and 20 have been canceled. Applicant respectfully submits that dependent claims 4, 5, 7-11, and 17 are allowable for at least the reasons provided above for their respective base claims as well as in view of their own combinations of features.

Dependent Claims 3, 6, 13-15, 18, and 19

Claim 3 was rejected under 35 U.S.C. § 103 as having been obvious over the Bolser and Kay et al. patents. Claim 6 was rejected under 35 U.S.C. § 103 as having been obvious over the Bolser, Kay et al., and Bunk patents. Claim 13 was rejected under

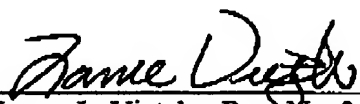
35 U.S.C. § 103 as having been obvious over the Bolser and Huang patents. Claim 14 was rejected under 35 U.S.C. § 103 as having been obvious over the Bolser and Kageyama et al. '693 patents. Claims 15, 18 and 19 were rejected under 35 U.S.C. § 103 as having been obvious over the Bolser and Rosenthal patents.

Claims 18 and 19 have been canceled. Applicant respectfully submits that dependent claims 3, 6, and 13-15 are allowable for at least the reasons provided above for their respective base claims as well as in view of their own combinations of features.

In view of the above amendments and remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Respectfully submitted,

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